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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,205	02/27/2004	Hilmar Wechsel	08020.0013-00	4680
22852	7590	09/17/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER NGUYEN, THUY-VI THI	
			ART UNIT 3689	PAPER NUMBER
			MAIL DATE 09/17/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/787,205

Applicant(s)

WECHSEL, HILMAR

Examiner

THUY VI NGUYEN

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
- Paper No(s)/Mail Date 06/28/04.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's election received on February /27/2004 wherein:

Claims 1-47 are currently pending

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 13-19, 32- 47** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 13 recites the limitation "*the pending delivery record*" in step (c). There is insufficient antecedent basis for this limitation in the claim. Furthermore, (step d) recites "*updating the return authorization and the pending delivery records using the return authorization number (RAN)*". It is unclear of how the RAN can be used for updating the record since the RAN is just a number. Therefore, it is interpreted as updating the return authorization and the pending delivery records.

Independent claims 32, 40 and 41 are vague and indefinite. The claims preamble recited "*a system for managing a product return, the method comprising*" are unclear whether they are system or method claim. If the claims 32-39 are the system

claim, then terms "database" is defined as a file composed of records and therefore is not considered as a system claim.

Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8, 9-12, 13-19, 20 are reject under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to **claims 1-20**, the claim language does not transform the underlying subject matter and the process is not tied to another statutory class. For instance in claim 1, the process steps of "*receiving, determining, issuing, creating, and updating*" is not tied to another statutory class, such as an apparatus, and thus, the claims are directed to nonstatutory subject matter.

Claims 21-23, 24-30, 31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims calls for "*a computer readable medium*" and the specification indicated (on par. 0063) that it can be a carrier

wave. Carrier wave is a form of electromagnetic energy which is nonstatutory because it is a natural phenomenon O'Reilly, 56 US (15 HOW.) at 112-14. Moreover, it does not appear that a signal such as a carrier wave falls within one of the four categories of patentable subject matter set forth in 35 U.S.C. § 101, i.e., process, machine, manufacture or composition of matter. Therefore, the claims are directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-47** are rejected under 35 U.S.C. 102(b) as being anticipated by Junger (US 6,463,421).

As for independent claim 1, Junger discloses a method for managing a return of a product, the method comprising:

receiving a return request for the product {see figures 4A, 4B; col. 2, lines 49-57; col. 5, lines 14-19; and lines 31-47; discusses *submitting the information for the product which is to be return; and receiving a request for a product return*};

determining whether the return request is authorized {see abstract, lines 7-13 figure 3 (steps 320-326) and col. 2, lines 49-59; col. 8, lines 21-32 *...identifying information to determine whether the returned product is pre-reproved for return*};

issuing, from a first management system, a return authorization number (RAN) for the return request when the return request is determined to be authorized {see figure 2; col. 4, lines 47-51; col. 5, lines 13-17 *discusses a return side (21) including computer 210 as a first management system; see abstract, lines 14-17; and col. 2, lines 60-64; providing a return authorization number (RAN) for a batch of approved return*}

creating a record in a second management system for the return request, the record comprising the RAN {see figure 2, *a manufacture side computer (230) is a second management system; data storage unit (234) for storing product; figure 3, step 328 for creating a return authorization number (RAN); see col. 5, lines 47-50 discusses return product information are saved in memory*};

updating the record in the second management system after the product has been returned {see figure 3; col. 7, lines 1-11; col. 8, lines 26-30 *for update the return product information*};

As for claim 2, Junger discloses wherein the first management system is a customer relationship management (CRM) system { see figures 1-2 for a return side (21)}.

As for claim 3, Junger discloses wherein the second management system comprises at least one of a supply chain management (SCM) management system and a warehouse management (WM) system {see figures 1-2; *a manufacture side (23)*}.

As for claim 4, Junger discloses wherein the record is a delivery request {see figures 3, 4A-4H}. Note: as for the term record is "delivery request" is non functional descriptive material (NFDM) and is given no patentable weight. See MPEP 2106.01.

As for claim 5, Junger discloses communicating information between the first and second management systems utilizing the RAN {see figures 3, col. 4A-4H; col. 6, lines 1-31}.

As for claim 6, Junger discloses providing a shipping label in response to approving the return request, the shipping label comprising the RAN {see figure 5A; col. 8, lines 53-65}.

As for claim 7, Junger discloses the return request is for a quantity of the product greater than one {see figures 4A-4H}.

As for claim 8, Junger discloses splitting the record in the second management system into a plurality of new records with the RAN when less than all of the quantity is received {see figures 3-4H; col. 7, lines 1-13}.

As for claim 9, Junger discloses a method for managing a product return, the method comprising:

authorizing a request from a customer to return a product {see figures 4A, 4B; col. 2, lines 49-57; col. 5, lines 14-31; and lines 31-47; discusses *submitting the information for the product which is to be return; and receiving a request for a product return; and authorized the returns*};

creating at least one record in each of a plurality of management systems when the request for the product return is authorized [see figures 2, 3 (step 304), 4A-4H; col. 2, lines 49-66; col. 5, lines 4-31; *for the record of product return of the return center (210) and manufacture (230)*];

assigning a unique identifier to the product return {see col. 2, lines 60-64 and figure 3; *create a return authorization number (328)*};

associating the unique identifier with each record corresponding the product to be returned {see figures 4A, and 5A; col. 6, lines 19-31; col. 8, lines 33-40; and lines 53-60; the RA (*returning authorization number*) or (*unique identifier*) is displayed on the RA status display screen; placing this RA number on the product prior shipping; ;

exchanging information regarding the product return between the plurality of management systems utilizing the unique identifier [figures 2, 3, and 4A-4G; col. 2, lines 49-66; col. 5, lines 4-30 discusses the exchange information from the product return center location (21) and a manufacture site (23) utilizing the identifying information e.g. return authorization number (unique identifier)].

As for claim 10, Junger discloses wherein the plurality of management systems comprises at least one of a customer relationship management (CRM) system, a supply chain management (SCM) system and a warehouse management (WM) system {see figures 1-2}.

As for claim 11, Junger discloses wherein the plurality of management systems comprises the warehouse management (WM) system {see figures 1-2}.

As for claim 12, Junger discloses plurality of management systems comprises a logistics, execution and shipping (LES) management system {see figures 1-2; col. 3, lines 66-67; col. 4, lines 1-5}.

As for claim 13, Junger discloses a method for managing a product return, the method comprising:

assigning at least one return authorization number (RAN) to the product return {see col.8, lines 53-58; figures 4H, and 5A; discusses *"RA number is placed on the products prior to shipping to the manufacture"*};

creating in a first database a return authorization record for the product return, the return authorization record comprising the RAN {see figures 2, col. 4, lines 50-53; discusses *"a return side computer 210 include a volatile memory (RAM)"*; and see figures 4A-4H; col. 6, lines 1-11 and lines 38-54; col. 7, lines 47-56, and col. 8, lines 32-41 shows creating a return product record from computer 210; e.g. *batch number; UPC number, product serial number, and the RA number*}.

creating, in a second database, a warehouse record for the product return, the pending delivery record comprising the RAN {see figures 2- 3 manufacturer computer (230), database (234); col. 6, lines 19-31; col. 7, lines 1-25; and shows *at the return product record (warehouse record), batch number, return product status e.g. "pending" and the RA number*}

and updating the return authorization and the pending delivery records {figure 3; figure 4H; col. 7, lines 1-25; col. 8, lines 26-30 *for update the return product information and pending return product*};

As for claim 14, Junger discloses wherein the return authorization record comprises a plurality of return authorization items {see figures 4A-4H}.

As for claim 15, Junger discloses wherein each return authorization item comprises a unique RAN {see figure 4H}.

As for claim 16, Junger discloses, wherein the warehouse record comprises a plurality of pending delivery items, each of the pending delivery items being created for at least one of the return authorization items {see figure 4H}.

As for claim 17, Junger discloses wherein the second database is a warehouse management (WM) system {see figure 1-2}.

As for claim 18, Junger discloses wherein the return authorization record further comprises a product type and a quantity {see figures 4A-4H}.

As for claim 19, Junger discloses further comprising creating a shipping label based on the return authorization record and communicating the shipping label to a customer {see figure 5A}.

As for claim 20, Junger discloses a method for managing a product return, the method comprising:

indexing a record in a first database for a product return using at least one unique identifier [see col. 6, lines 1-11; lines 38-54; col. 7, lines 47-56; figures 4B-4F; the return center operator enter from the computer (210) information regarding *the return product, e.g. UPC number, product serial number etc*];

creating a record for the product return in a second database, the record in the second database comprising the unique identifier {see col. 6, lines 19-31; and lines 66-67; col. 7, lines 1-14; *creating a new batch (record) includes information identifying the assigned batch number, UPC number, product serial number*}; and

exchanging, between the first and second databases, information related to the product return, wherein each item of exchanged information is identified by the unique

identifier {figures 2, 3, and 4A-4G; col. 2, lines 49-66; col. 5, lines 4-30 discusses the exchange information from the product return center location (21) and a manufacture site (23) utilizing the identifying information e.g. return authorization number (unique identifier)}.

As for claim 21, Junger discloses a computer readable medium containing instructions for carrying out a method for managing a product return, the method comprising:

creating a record in a customer relationship management (CRM) system for a product return using at least one return authorization number {see figures 1-2, col. 4, lines 50-53; discusses "a return side computer 210 in a return side (21). The return site is interpreted as (CRM); and see figures 4A-4H; col. 6, lines 1-11 and lines 38-54; col. 7, lines 47-56, and col. 8, lines 32-41 shows creating a return product record from computer 210; e.g. *batch number*; *UPC number*; *product serial number*, and the *RA number*};

creating a record for the product return in a warehouse management (WM) system using the return authorization number {see figures 2- 3 manufacturer computer (230), or (WM); and col. 6, lines 19-31; col. 7, lines 1-25; shows *all the return product record is created*; e.g., *batch number*, *return product status e.g. "pending"* and the *RA number*}; and

exchanging between the management systems information related to the product return, wherein each item of exchanged information is identified by the return authorization number {figures 2, 3, and 4A-4G; col. 2, lines 49-66; col. 5, lines 4-30

discusses the exchange information from the product return center location (21) and a manufacture site (23) utilizing the identifying information e.g. return authorization number (unique identifier)}.

As for claim 22 Junger discloses, wherein the record in the CRM system is a return authorization record {see figures 3, 4A-4H}.

As for claim 23, Junger discloses, wherein the record in the WM system is a pending delivery record {see figure 4H}.

As for independent claim 24 which is about a computer readable medium containing instructions for carrying a method of managing a return of a product. This claim has the same limitation as independent claim 13 above. Therefore it is rejected as the same independent claim 13 sets forth above.

As for claim 25, Junger discloses wherein the return authorization record comprises a plurality of return authorization items {see figures 4A-4H}.

As for claim 26, Junger discloses wherein each return authorization item comprises a return authorization number {see figures 4A-4H}..

As for claim 27, Junger discloses, wherein a pending delivery item is created for each return authorization item {see figures 4A-4H}.

As for claim 28, Junger discloses wherein the second database is a warehouse management database {see figure 2}.

As for claim 29, Junger discloses wherein the return authorization record further comprises a product type and a quantity {see figures 4A-4H}.

As for claim 30, Junger discloses further comprising creating a shipping label based on the return authorization record and communicating the shipping label to a customer {see figure 5A}.

As for independent claim 31 which is about a computer readable medium containing instructions for carrying a method of managing a return of a product. This claim has the same limitation as independent claim 9 above. Therefore it is rejected as the same independent claim 13 sets forth above.

As for independent claim 32, Junger discloses a system for managing a return of a product, the method comprising:

a first database configured to receive a return request for the product, and to generate a first record comprising a return authorization number (RAN) for the product if the return request is authorized {see figures 2, col. 2, lines 49-57 (*receiving a return product*); col. 4, lines 50-53; discusses "*a return side computer 210 include a volatile memory (RAM)*" ; and see figures 4A-4H; col. 6, lines 1-11 and lines 38-54; col. 7, lines 47-56, and col. 8, lines 32-41 shows creating a return product record from computer 210; e.g. *batch number; UPC number, product serial number, and the RA number*}.

a second database, in communication with the first database, configured to create a second record corresponding to the return, the second record comprising the RAN {see figures 2- 3 manufacturer computer (230), database (234); col. 6, lines 19-31; col. 7, lines 1-25; and shows *at the return product record (warehouse record), batch number, return product status e.g. "pending" and the RA number*}; and

wherein the first and second database are each configured to exchange information regarding the return utilizing the RAN {figures 2, 3, and 4A-4G; col. 2, lines 49-66; col. 5, lines 4-30 discusses the exchange information from the product return center location (21) and a manufacture site (23) utilizing the identifying information e.g. return authorization number (unique identifier)}.

As for claim 33, Junger discloses wherein the first record is a return authorization record {see figures 4A-4H}.

As for claim 34, Junger discloses wherein the return authorization record comprises a plurality of return authorization items, each corresponding to a unique RAN {see figure 4A-4H}.

As for claim 35, Junger discloses wherein the second record is a pending delivery record {see figure 4H}.

As for claim 36, Junger discloses wherein the pending delivery comprises a plurality of pending delivery items each corresponding to a return authorization item {see figures 4A-4H}.

As for claim 37, Junger discloses wherein a quantity of the returned item is greater than one {see figure 4A-4H}.

As for claim 38, Junger discloses wherein the first database is configured to split the first record when not all of the quantity is returned {see figure 4A-4H}.

As for claim 39, Junger discloses wherein the second database is configured to split the second record when not all of the quantity is returned {see figure 4A-4H}..

As for independent claim 40, Junger discloses a system for managing a product return comprising:

a computer configured to assign a return authorization number (RAN) to a product return {see figures 2- 3; col. 4, lines 47-51; col. 5, lines 13-17and abstract, lines 14-17; and col. 2, lines 60-64; (computers 210 and 230) *providing a return authorization number (RAN) for a batch of approved return*}

a plurality of databases, each configured to receive the RAN and to create at least one record corresponding to the product return, wherein each record corresponding to the return item is uniquely associated with the RAN {see figures 2, 3, and 4A-4H; col. 4, lines 50-54; col. 5, lines 4-10; and col. 6, lines 1-48; discusses creating a return product record from *computer (210) with RAM and computers 230 , database 234*}.

As for independent claim 41, Junger discloses a system for managing a product return, the system comprising:

a first computer comprising a user interface for receiving a return request from a customer, creating a first record comprising a return authorization number (RAN), and transmitting to the customer an authorization for a product return comprising the RAN {see figures 2-3, col. 4, lines 50-53; discusses "*a return side computer 210*" and see figures 4A-4H; col. 6, lines 1-11 and lines 38-54; col. 7, lines 47-56, and col. 8, lines 32-41 shows creating a return product record from computer 210; e.g. *batch number; UPC number, product serial number, and the RA number*};

a second computer, in communication with the first computer, configured to receive the RAN, and to create, upon receipt of the return authorization, a record in a database comprising the RAN {see figures 2- 3 manufacturer computer (230); col. 5, lines 4-12; col. 6, lines 19-31; col. 7, lines 1-25; and shows *all the return product record batch number, return product status e.g. "pending" and the RA number*};

As for claims 42-44, which deals with the communication between the customer and manufacture for the product return using the website for transmitting the label. This is taught in Junger in figures 2-3, 5A; col. 7, lines 1-14}

As for claim 45-47, which deals with the method of communication using the EDI, (electronic data interchange), Basic Application Interface (BAPI) and R/3 information object. This is inherently included Junger {col. 4, lines 46-62; col. 5, lines 4-12}, figures 4A-4H}, wherein the first and second computers communicate using an EDI. Moreover, using these parameters for communicating between two systems are common, old and well known in the art.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
8. The US Patent to Tsunenari et al. discloses system and methods to effect return of a consumer product.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-

1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689